

REMARKS

The Amendments

Claim 53 is amended to recite that the halogen in the definition of the groups for R¹⁷ is a fluoro group. Support for the amendment is found throughout the specification. For example, see page 11, line 23; and all of the specifically recited compounds beginning on page 21, wherein, when R¹⁷ is halogen, it is always fluoro.

To the extent that the amendments avoid the prior art or for other reasons related to patentability, competitors are warned that the amendments are not intended to and do not limit the scope of equivalents which may be asserted on subject matter outside the literal scope of any patented claims but not anticipated or rendered obvious by the prior art or otherwise unpatentable to applicants. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The Rejection under 35 U.S.C. §112, first paragraph

The rejection of claims under 35 U.S.C. §112, first paragraph, on the basis that there is no written description of the proviso in claim 53, is respectfully traversed.

The proviso in claim 53 disclaims four compounds. These four compounds are specifically disclosed in the specification (see e.g., Examples 1, 2, 31 and 32) each as one alternative embodiment of the compounds of the invention. The disclosure does not require that these four compounds be present in all embodiments of the invention. Since each is merely one possible compound to select, the disclosure provides support for embodiments which contain these compounds and for embodiments which exclude these compounds.

The facts here are indistinguishable from In re Johnson, 194 USPQ 187 (CCPA 1977), which upheld that, under U.S. law, it is acceptable to add provisos limiting the scope

of the claims without the need for any specific disclosure of the exclusion. The basis for Johnson, which applies here, is that, since the whole scope of the original genus is clearly supported, a scope which only eliminates a small part of such scope must also be supported. In Johnson, the application described a genus encompassing a large number of species and described a number of specific species. Two of the specifically described species were excluded by proviso. Although there was no description at all in the specification that these two species should be excluded, it was held that the claim reciting the proviso was supported by the disclosure under 35 U.S.C. §112, first paragraph. The same facts are present here. The following statement by the Court in Johnson thus fully applies here:

"The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and thus has failed to satisfy the requirement of §112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute."

That this proviso excludes four compounds does not change the applicability of Johnson's holding here.

For the reasons supporting the Johnson decision, the proviso recited in claim 53 is not lacking support in the instant disclosure and the rejection under 35 U.S.C. §112, first paragraph, should be withdrawn.

The Rejection under 35 U.S.C. §102

The rejection of claim 53 under 35 U.S.C. §102, as being anticipated by Arunachalem is believed to be rendered moot by the above amendment.

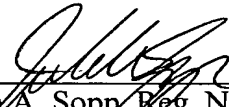
The claims no longer encompass compounds wherein the group at the R¹⁷ position is iodo. The compounds of the reference which were cited in support of the rejection where

only compounds wherein the R¹⁷ position was iodo. The compounds of the reference do not meet the literal scope of the instant claims. Thus, the claims are not anticipated and the rejection under 35 U.S.C. §102 should be withdrawn. Further, it would not have been obvious to modify the Arunachalem compounds to remove or replace the iodo group since providing an iodo-substituted compound is a primary objective of the reference and such modification would be contrary to that objective. Thus, the reference also does not support an obviousness rejection.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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